



UNITED STATES PATENT AND TRADEMARK OFFICE

cen

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,671	03/15/2004	Jari Mutikainen	47092.00075	8603

32294 7590 11/30/2007
SQUIRE, SANDERS & DEMPSEY L.L.P.
14TH FLOOR
8000 TOWERS CRESCENT
TYSONS CORNER, VA 22182

EXAMINER

LIU, BEN H

ART UNIT	PAPER NUMBER
----------	--------------

2616

MAIL DATE	DELIVERY MODE
-----------	---------------

11/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/799,671

Applicant(s)

MUTIKAINEN ET AL.

Examiner

Ben H. Liu

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date March 14, 2005.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 41 recites the limitation "said conference call application" in claim 41 lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 54 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For claim 54, the claim is directed to a computer program per se, which is non-statutory subject matter. The claim recites a computer program product comprising code. The claim fails to mention a computer readable medium encoded with, stored with, or embodied with "computer

executable instructions.” Without these components the functionality of the claimed invention cannot be carried out.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-10, 12-17, 19-36, 38-39, and 41-54 rejected under 35 U.S.C. 102(e) as being anticipated by Kallio et al. (US Patent Application Publication 2004/0190498).

For claim 1, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, the method comprising the steps of: a) delivering a temporary routing number to the user terminal (*see paragraphs 10-14, which recite forwarding address information to establish inter-networking between an IP based packet-switched network and a circuit-switched network*); and b) establishing a circuit-switched call leg from the user terminal to the packet-switched network using the routing number (*see paragraphs 10-14, which recite establishing a call leg towards the circuit-switched network based on the forwarded address information*).

For claim 2, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the delivering step

comprises delivering routing number comprising an E.164 number (*see paragraph 41, which recites establishing a call using an E.164 number*).

For claim 3, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the delivering step comprises performing using at least one session initiation protocol session setup message (*see paragraph 47, which recites a conference setup based on a dial-in type of SIP conference*).

For claim 4, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the performing step comprises keeping the session initiation protocol session active during the circuit-switched call (*see paragraph 62, which recites an active ongoing session from the IMS domain that is able to receive further REFER messages*).

For claim 5, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, further comprising an additional step of detecting whether the circuit-switched call leg is supported by the user terminal and the packet-switched network before the delivering step (*see paragraph 44, which recites a session initiation protocol INVITE message. An OK message response indicates that the call leg is supported*).

For claim 6, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the detecting step comprises performing within a registration procedure (*see paragraph 44, which recites a session initiation protocol INVITE message. An OK message response indicates that the call leg is registered*).

For claim 7, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the establishing step comprises establishing the circuit-switched call leg comprising a call leg from an originating call *(see paragraph 15, which recites establishing call legs between two connection ends, one of which is a call leg from an originating call)*.

For claim 8, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the establishing step comprises establishing the circuit-switched call leg is a call leg from a terminating call *(see paragraph 15, which recites establishing call legs between two connection ends, one of which is a call leg from a terminating call)*.

For claim 9, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the delivering step comprises delivering the routing number to the user terminal from a call control element of the packet-switched network *(see paragraph 35, which recite a media gateway control function that sends an initial address message to the GSM network to establish a first call leg in the circuit switched domain)*.

For claim 10, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the establishing step comprises locating the user terminal outside its home network *(see paragraph 53, which recites a visiting mobile switching center (VMSC) used when the user terminal is outside of the home network)*.

For claim 12, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the establishing step comprises performing using integrated services digital network user part (*see paragraph 23, which recites using an integrated services digital network user part to establish a connection*).

For claim 13, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, further comprising providing a packet-switched conference call service to the circuit-switched network using the connection, and wherein the method comprises the steps of: transmitting, via a data path, a conference request directed to an application server which provides the conference call service (*see paragraphs 35 and 41, which recite an application server that uses a REFER session initiated protocol message to the to create a voice call*); receiving, via the data path, the temporary routing number as a conference routing number for a requested conference call in response to the conference request (*see paragraph 35, which recites sending an initial address message in response to the REFER message*); and using the received conference routing number to set up the circuit-switched call leg as a call leg of the conference call (*see paragraph 35, which recites using the initial address message to establish a call leg towards the terminal device located in the circuit switched domain*).

For claim 14, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, further comprising the step of selecting participants of the conference call and adding to the conference request an information specifying the selected participants (*see paragraphs 37 and 44, which recite a call*

that consists of all participants in a conference invited by a common source. An INVITE message is forwarded to the conference equipment specifying the desired participants).

For claim 15, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the transmitting step comprises performing based on a pre-configured address information (*see paragraph 45, which recites a server initiated SIP conference based upon a pre-determined time or application-dependent action. The action trigger causes the conference equipment to send INVITE messages to pre-determined participants).*

For claim 16, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, further comprising the step of setting the pre-configured address information in a service subscription stage (*see paragraph 45, which recites a server initiated SIP conference based upon a pre-determined time or application-dependent action. The desired participants and their corresponding address information are pre-configured for the server initiated SIP conference to work).*

For claim 17, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, further comprising the step of adding session-related information to the conference request, the session-related information comprising at least one of a subject: picture of the subject, payer of the conference, importance of the conference session, animation, video clip, sound clip, and textual description (*see paragraph 46, which recites a charging model which designates the conference initiator as the payer of the conference).*

For claim 19, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the transmitting step comprises transmitting via the data path that comprises a unstructured supplementary service data, wireless application protocol, or hyper text transfer protocol channel (*see paragraph 35, which recite a GSM subscriber with a terminal device used to connect to a packet switched network from a circuit-switched network. GSM terminal devices are typically capable of transmitting unstructured supplementary service data, wireless application protocol, or hyper text transfer protocol channel data*).

For claim 20, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the transmitting and receiving steps comprise performing using session initiation protocol (*see paragraph 35, which recites sending the Media Gateway Control Function a REFER session initiation protocol message to initiate a conference call for SIP-based conferencing functionality*).

For claim 21, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the transmitting and receiving steps comprise performing using at least one session initiation protocol or service description protocol extension for communicating circuit-switched specific information (*see paragraph 35, which recites sending the Media Gateway Control Function a REFER session initiation protocol message. The Media Gateway Control Function then uses the message to establish a call leg to the terminal device in the circuit switched domain*).

For claim 22, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the providing step

comprises setting up the circuit-switched connection to a media gateway control device which then routes the circuit-switched call to the application server (*see paragraph 41, which recites an application server that sends REFER messages to the Media Gateway Control Function to establish a call between two subscribers*).

For claim 23, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, further comprising the step of converting the routing number into a packet-switched conference address at the media gateway control device (*see paragraph 41, which recites an application server that sends REFER messages to the Media Gateway Control Function to establish a call between two subscribers using the native SIP URI address in the packet-switched network*).

For claim 24, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, further comprising the steps of: reserving the routing number as a temporary conference routing number at the application server during establishment of the conference call; and releasing the routing number for reuse after releasing the conference call (*see paragraph 37, which recites a unique call-ID for identifying SIP calls, which is valid for the duration of the call*).

For claim 25, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, further comprising the step of forwarding a join request to join the conference call from the application server to other participants specified in the conference request via a data path (*see paragraph 44, which recites inviting potential participants to join an existing conference*).

For claim 26, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the forwarding step comprises transmitting the request using a session initiation protocol Invite message triggered by a received session initiation protocol refer message (*see paragraph 44, which recites a SIP INVITE message to potential participants in response to receiving a SIP REFER message*).

For claim 27, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the forwarding step comprises forwarding the join request that comprises: at least one of an identification of the conference initiator; a subject of the conference call; a price of the conference call leg; and an information about a moderation of the conference call, an animation, a video clip, a sound clip, and a textual description (*see paragraph 44, which recites a SIP INVITE message to potential participants in response to receiving a SIP REFER message. The REFER message contains the URI address of the conference owner*).

For claim 28, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, further comprising a step of: forwarding, via another data path, the conference routing number from the application server to a requested participant specified in the conference request to indicate that the conference call will be established from the conference number to the requested participant, wherein at least one circuit-switched connection is set up from the application server using the conference number as a calling party number via a media gateway control device, which then routes the conference call to the requested participant (*see paragraph 41, which recites an application server that sends a*

REFER message to a media gateway control function to establish a call to the requested applicant).

For claim 29, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, further comprising the step of forwarding a kick-out request to the application server via the data path to thereby have a participant excluded from the conference call (*see paragraph 44, which recites SIP REFER messages are used to establish a conference call with potential participants. Subsequently, a SIP BYE message can be used to terminate a call with a participant to exclude that participant from the conference call*).

For claim 30, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the forwarding step comprises forwarding the kick-out request that comprises an identification of the conference call and an identification of at least one the participant to be excluded (*see paragraph 44, which recites SIP REFER messages are used to establish a conference call with potential participants. Subsequently, a SIP BYE message containing the URI address of the participant to be excluded from the conference call can be used to terminate the call leg*).

For claim 31, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the receiving step comprises receiving the temporary routing number for the conference call, the conference call supports at least one of: an audio component, a non-real time video component; an application component; and a messaging component (*see paragraph 6, which recite audio, video, and chat*

capabilities on a SIP network, and paragraph 9, which recites enabling internetworking between a packet switched and circuit-switched network through SIP enabled terminals).

For claim 32, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the connection setup is performed by using a conference policy control protocol over an Mt interface as a data path *(see paragraph 35, which recite internetworking between an IMS packet-switched network and a GSM circuit-switched network. The MT interface for policy control is specified in GSM networks).*

For claim 33, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, further comprising the steps of: forwarding, via another data path, a join request to join the conference call from a requesting participant to at least one requested participant specified in the conference request *(see paragraph 44, which recites inviting potential participants to join an existing conference),* wherein the join request comprises the conference routing number and a connection setup step comprising setting up a circuit switched connection from the at least one requested participant to application server using the conference routing number *(see paragraph 44, which recites a conference equipment which sends out a SIP REFER message to potential participants to set up a call legs to the participant).*

For claim 34, Kallio et al. disclose a method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network, wherein the forwarding step comprises forwarding the request using session initiation protocol Refer message and the connection setup step comprises establishing the at least one circuit switched connection using

session initiation protocol Invite message (*see paragraph 44, which recites receiving a SIP REFER message and in response sends out a SIP INVITE message to establish call legs to the potential participants*).

For claim 35, Kallio et al. disclose a terminal device for providing a connection to a packet-switched network via a circuit-switched network, the terminal device comprising: a) communicating means for receiving a temporary routing number delivered to a user terminal (*see paragraphs 10-14, which recite forwarding address information to establish inter-networking between an IP based packet-switched network and a circuit-switched network*); and b) establishing means for establishing a circuit-switched call leg from the user terminal to the packet-switched network using the temporary routing number (*see paragraphs 10-14, which recite establishing a call leg towards the circuit-switched network based on the forwarded address information*).

For claim 36, Kallio et al. disclose a terminal device for providing a connection to a packet-switched network via a circuit-switched network, wherein the connection is used to provide a packet-switched conference call service in the circuit-switched network, the communication means is configured to transmit via a data path a conference request directed to an application server which provides the conference call service (*see paragraphs 35 and 41, which recite an application server that uses a REFER session initiated protocol message to the to create a voice call*), and to extract the temporary routing number as a conference routing number from a response received via the data path (*see paragraph 35, which recites an initial address message in response to the REFER message*); and wherein the establishing means is configured to establish the circuit-switched call leg using the extracted conference routing

number (*see paragraph 35, which recite using the initial address message to establish a call leg towards the terminal device located in the circuit switched domain*).

For claim 38, Kallio et al. disclose a terminal device for providing a connection to a packet-switched network via a circuit-switched network, wherein the communication means is configured to use a session initiation protocol message for forwarding the conference request (*see paragraph 35, which recites sending the Media Gateway Control Function a REFER session initiation protocol message to initiate a conference call for SIP-based conferencing functionality*).

For claim 39, Kallio et al. disclose a terminal device for providing a connection to a packet-switched network via a circuit-switched network, wherein the communication means is configured to use at least one session initiation protocol or service description protocol extension for communicating circuit-switched specific information (*see paragraph 35, which recites sending the Media Gateway Control Function a REFER session initiation protocol message. The Media Gateway Control Function then uses the message to establish a call leg to the terminal device in the circuit switched domain*).

For claim 41, Kallio et al. disclose a terminal device for providing a connection to a packet-switched network via a circuit-switched network, wherein the conference call application is implemented as a native client application or as a midlet application (*see paragraph 58, which recites a SIP agent that is a native application on the terminal device for establishing communication using SIP messages*).

For claim 42, Kallio et al. disclose a terminal device for providing a connection to a packet-switched network via a circuit-switched network, wherein the communication means are

configured to transmit the conference request in consequence of receiving a first request from another user (*see paragraph 38, which recites a session transfers in SIP networks using the REFER message. The REFER message contains a "referred-to" and "referred-by" component used to transfer conference sessions between SIP users*).

For claim 43, Kallio et al. disclose a server device for providing a connection from a packet-switched network to a circuit-switched network, the server device comprising: communicating means for receiving from the circuit-switched network, a connection request via a data path (*see paragraph 35, which recites a Media Gateway Control Function that receives a SIP REFER message to establish SIP-based connection*); and means for delivering a temporary routing number for the circuit-switched network via the data path (*see paragraph 35, which recites responding to the REFER message by sending an initial address message*).

For claim 44, Kallio et al. disclose a server device for providing a connection from a packet-switched network to a circuit-switched network, wherein the connection is used to provide a packet-switched conference call service to the circuit-switched network (*see paragraph 35, which recites SIP-based conferencing between an IMS packet-switching network and GSM circuit-switched network*), the connection request is a conference request, and the temporary routing number is a conference routing number (*see paragraph 44, which recites a SIP REFER message which includes the URI address of the conference owner*).

For claim 45, Kallio et al. disclose a server device for providing a connection from a packet-switched network to a circuit-switched network, further comprising allocating means for allocating the conference routing number as a temporary E.164 number to the conference call

(see paragraph 41, which recites using the E.164 address in the "Refer-to" header of the SIP REFER message indicating the address of the conference owner).

For claim 46, Kallio et al. disclose a server device for providing a connection from a packet-switched network to a circuit-switched network, wherein the allocating means is configured to reserve a plurality of E.164 numbers for a plurality of conference calls *(see paragraph 41, which recites an E.164 address for each leg of the conference call, which allows for a plurality of conference calls).*

For claim 47, Kallio et al. disclose a server device for providing a connection from a packet-switched network to a circuit-switched network, wherein the reserved plurality of E.164 numbers comprises a plurality of toll-free numbers and a plurality of charged numbers *(see paragraph 41, which recites an E.164 address for each leg of the conference call, which allows for a plurality of conference calls. The E.164 address can comprise toll-free numbers and charged numbers).*

For claim 48, Kallio et al. disclose a server device for providing a connection from a packet-switched network to a circuit-switched network, wherein the allocating means is configured to select the E.164 number from the plurality of charged numbers included in the conference request *(see paragraph 41, which recites an E.164 address for each leg of the conference call, which allows for a plurality of conference calls. The conference request can select charged numbers for the E.164 address).*

For claim 49, Kallio et al. disclose a server device for providing a connection from a packet-switched network to a circuit-switched network, wherein the communication means is configured to send a conference routing number via a respective data path to other participants

specified in a conference request (*see paragraph 44, which recites a conference equipment which sends out a SIP REFER message to potential participants. The REFER message contains the URI of the conference owner used to identify a conference call*).

For claim 50, Kallio et al. disclose a server device for providing a connection from a packet-switched network to a circuit-switched network, further comprising: checking means for checking whether callers of received calls relating to the conference call match with the other participants specified in the conference request (*see paragraph 44, which recites identifying callers with their own URI as the originator address that should be the same as the address specified in the conference request REFER message*).

For claim 51, Kallio et al. disclose a server device for providing a connection from a packet-switched network to a circuit-switched network, further comprising a connection control means for connecting individual call legs of participants in a media gateway device (*see paragraph 36, which recites a Media Gateway Control Function that establishes individual call legs to terminal devices on different ends of the connection*).

For claim 52, Kallio et al. disclose a server device for providing a connection from a packet-switched network to a circuit-switched network, further comprising: interface means for providing a direct connection to a media gateway control device to enable routing of a set-up call for a conference call from the circuit-switched network to an application server (*see paragraph 41, which recites an application server that creates a voice call to a circuit-switched network through a selected Media Gateway Control Function*).

For claim 53, Kallio et al. disclose a server device for providing a connection from a packet-switched network to a circuit-switched network, further comprising means for

implementing media gateway controller functions in the server device (*see paragraph 33, which recites a Media Gateway Control Function which controls the Media Gateway function*).

For claim 54, Kallio et al. disclose a computer program product comprising code means configured to produce steps for establishing a connection from a user terminal to a packet-switched network via a circuit-switched network when loaded into a memory of a terminal device (*see paragraphs 35 and 58, which recite a SIP user at a terminal device that uses SIP-based conference functionality to establish a connection from a user terminal to a packet-switched network through a circuit-switched network. The SIP user agent is an application comprising code stored in memory to perform the connection.*).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kallio et al. (US Patent Application Publication 2004/0190498) in view of Mussman et al. (U.S. Patent 7,215,643).

For claims 11, Kallio et al. discloses all the subject matter of the claimed invention with the exception of converting the circuit-switched call leg into a voice-over internet protocol connection in a core network of the packet-switched network. Mussman et al. from the same or similar fields of endeavor disclose a method and system for communicating between a packet-switched network and a circuit-switched network where the packet-switched network comprises a Voice over Internet Protocol (VoIP) connection (*see column 3 lines 3-18*). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to use the method to communicate between a circuit-switched network and a VoIP packet-switched network as taught by Mussman et al. with the method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network as taught by Kallio et al. The method to communicate between a circuit-switched network and a VoIP packet-switched network as taught by Mussman et al. can be implemented with the method for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network as taught by Kallio et al. by configuring the terminal equipment to be VoIP network endpoints through software (*see Mussman et al., column 3 lines 28-30*). The motivation for combining the method to communicate between a circuit-switched network and a VoIP packet-switched network as taught by Mussman et al. with the method for establishing a connection from a

packet-switched network to a user terminal via a circuit-switched network as taught by Kallio et al. is to improve availability of service by enabling the routing of VoIP traffic over a circuit-switched public switched telephone network when VoIP resources are unavailable to complete the connection.

11. Claims 18, 37, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kallio et al. (US Patent Application Publication 2004/0190498) in view of Hyllander et al. (U.S. Patent 7,065,199).

For claims 18, 37, and 40, Kallio et al. discloses all the subject matter of the claimed invention with the exception wherein the communication means is configured to use a short message service channel for forwarding the conference request. Hyllander et al. from the same or similar fields of endeavor disclose a method and system that enables a GSM subscriber in a circuit-switched network to establish a telephone connection to an internet user in a packet-switched network using a short message service channel (*see column 2 lines 27-42*). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to use the system that enables a GSM subscriber in a circuit-switched network to establish a telephone connection to an internet user in a packet-switched network using a short message service channel as taught by Hyllander et al. with the system for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network as taught by Kallio et al. The system that enables a GSM subscriber in a circuit-switched network to establish a telephone connection to an internet user in a packet-switched network using a short message service channel as taught by Hyllander et al. can be implemented with the system for establishing

a connection from a packet-switched network to a user terminal via a circuit-switched network as taught by Kallio et al. by configuring the telephony/Internet server through software to receive and analyze SMS messages (*see Hyllander et al., column 2 lines 57-67*). The motivation to use the system that enables a GSM subscriber in a circuit-switched network to establish a telephone connection to an internet user in a packet-switched network using a short message service channel as taught by Hyllander et al. with the system for establishing a connection from a packet-switched network to a user terminal via a circuit-switched network as taught by Kallio et al. is to enable a GSM subscriber to establish a telephone connection with an internet user with additional equipment.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (*see form PTO-892*).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ben H. Liu whose telephone number is (571) 270-3118. The examiner can normally be reached on 9:00AM to 6:30PM.

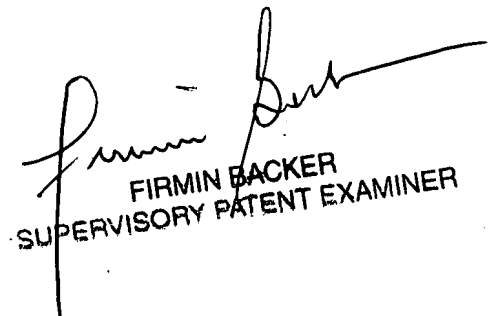
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on (571) 272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/799,671
Art Unit: 2616

Page 22

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BL


FIRMIN BACKER
SUPERVISORY PATENT EXAMINER